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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,197	02/27/2004	Katsumi Takehara	58647-180	4572
Kenneth L. Cage McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096				
EXAMINER				
HOEKSTRA, JEFFREY GERDEN				
ART UNIT		PAPER NUMBER		
3736				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/787,197

Applicant(s)

TAKEHARA, KATSUMI

Examiner

JEFFREY G. HOEKSTRA

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) 1-13 and 20-26 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 14-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Notice of Amendment

1. In response to the Amendment filed on 04/03/2008, amendment(s) to the specification is/are acknowledged. The following new and reiterated grounds of rejection are set forth:

Drawings

2. The drawings were received on 04/03/2008. These drawings are acceptable.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for duplicating, omitting, and/or not interrelating essential structural cooperative elements, such duplication, omission, and/or non-interrelation amounting to an indeterminate scope between the structural elements. See MPEP § 2172 and MPEP § 2172.01. The duplicated, omitted, and/or non-interrelated structural elements are: the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit".

6. As disclosed in the specification (see at least page 32 lines 3-11 and Figure 8) "a microcomputer (CPU) ... is not only bioelectrical impedance computation means for

computing a bioelectrical impedance from an applied electric current and a measured voltage but also correction means for correcting the computed bioelectrical impedance. Further, it also body composition means for computing an index related to the composition of a living body".

7. Therefore, as disclosed the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit" appear to be components of a singular microprocessor and/or microcomputer and each of the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit" given a broadest reasonable interpretation appear to duplicate the omitted microprocessor and/or microcomputer structure.

8. Moreover, the scope of the claim(s) is indefinite with respect to the relationship and/or interrelation, or lack thereof, between the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit". As claimed the distinct "unit(s)" are not "connected" and/or "disposed in an operable data communication" as disclosed in the specification (see at least page 32 lines 3-11 and Figure 8).

9. For the purposes of examination on the merits, the Examiner notes that the claimed limitations "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit" will be examined as a singular microprocessor with the respective functions of the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit".

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamada et al (US 2001/0007924 A1, hereinafter Kamada).

12. For claims 14 and 17, Kamada discloses a body composition measuring apparatus as broadly as structurally claimed, comprising:

- an electric current applying unit (21) for applying a variable electric current to a living body (paragraphs 33 and 42);
- a voltage measuring unit (25) for measuring a voltage (paragraphs 33 and 43); and
- a programmable microprocessor (block 1) capable of being programmed to comprise a bioelectrical impedance computing program unit, a correcting program unit, and a body composition computing program unit and capable of being programmed to (a) compute a parameter (the bioelectrical impedance vector positively recited in paragraph 45) associated with a bioelectrical impedance of a measured body part from the applied electric current and the measured voltage at a given frequency (paragraphs 44-47), (b) compute a correction for correcting the parameter value associated with the measured bioelectrical impedance by use of a parameter (paragraphs 11 and 14) (the ICW/ECW positively recited in paragraph 62) representing an intracellular/extracellular fluid ratio which is included in the parameter value of the bioelectrical impedance measured at a given frequency

(paragraph 42), and (c) compute an index (S19) associated with a body composition based on the corrected parameter value associated with the bioelectrical impedance.

13. For claim 15, Kamada discloses a body composition measuring apparatus, wherein the given frequency is the frequency of the electric current applied to the living body for estimation of the body composition (as best seen in Figure 10) (paragraph 42).

14. For claim 16, Kamada discloses a body composition measuring apparatus, wherein the given frequency is a frequency different from the frequency of the electric current applied to the living body for estimation of the body composition (as best seen in Figure 10) (paragraph 42).

15. For claim 18, Kamada discloses a body composition measuring apparatus capable of computing the following mathematical relation: when the parameter associated with the bioelectrical impedance which has been corrected by the parameter associated with the bioelectrical impedance which represents the intracellular/extracellular fluid ratio is P' , the correction of the parameter associated with the bioelectrical impedance in the correcting unit is made in accordance with the following correction expression: $P' = f(P, \alpha) = (K)(P^A)(\alpha^B) + C$ wherein $f(P, \alpha)$ is a correction function represented by parameters P and α , P' is the corrected parameter associated with the bioelectrical impedance, P is the measured parameter associated with the bioelectrical impedance, α is the parameter associated with the bioelectrical impedance which represents the intracellular/extracellular fluid ratio, and A , B , C and K are constants.

16. For claim 19, Kamada et al discloses a body composition measuring apparatus capable of computing the following mathematical relation: the parameter α associated with the bioelectrical impedance, which represents the intracellular/extracellular fluid ratio, is expressed as follows by use of a phase difference ϕ between the waveform of the alternating current applied from the electric current applying means to the living body and the waveform of the voltage measured by the voltage measuring means at the time of measurement of the bioelectrical impedance: $\alpha = 1/\phi$.

Response to Arguments

17. Applicant's arguments filed 04/03/2008 have been fully considered but they are not persuasive. Applicant argues the rejection of the claims under 35 USC 112.2 and the rejection of the claims under 35 USC 102(b) as being anticipated by Kamada.

18. Specifically Applicant argues

(a) the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit" are properly interrelated and that the 112.2 rejection MPEP does not support such a rejection,

(b) there is no basis for interpreting the claim elements as being necessarily part of a single microprocessor or microcomputer,

(c) the elements perform different functions and would most likely be performed by a different part of the microprocessor and/or microcomputer,

(d) Kamada does not disclose or suggest the correcting unit that corrects a parameter value associated with the measured bioelectrical impedance by use of a

parameter representing an intracellular/extracellular fluid ratio included in the parameter value of the bioelectrical impedance measured at a given frequency,

(e) Kamada does not disclose or suggest the body composition computing unit that computes an index associated with a body composition based on the corrected parameter value, and

(f) Kamada does not disclose or suggest correcting any parameters.

19. The Examiner disagrees, maintains the rejections as set forth and reiterated above, and in response notes the following:

20. In response to Applicant's argument (a) that the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit" are properly interrelated and that the 112.2 rejection MPEP does not support such a rejection, the Examiner notes the claims as broadly as structurally claimed establish no interrelation between the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit", the claimed elements appear to duplicate parts of the microprocessor and/or microcomputer as broadly as structurally claimed (see at least page 32 lines 3-11 and Figure 8 "a microcomputer (CPU) ... is not only bioelectrical impedance computation means for computing a bioelectrical impedance from an applied electric current and a measured voltage but also correction means for correcting the computed bioelectrical impedance. Further, it also body composition means for computing an index related to the composition of a living body"), and the claims do not positively recite a "microprocessor" and/or "microcomputer"

comprising the "a bioelectrical impedance computing unit", the "a correcting unit", and the "a body composition computing unit".

21. In response to Applicant's argument (b) that there is no basis for interpreting the claim elements as being necessarily part of a single microprocessor or microcomputer, the Examiner notes as disclosed the elements are part of a single microprocessor or microcomputer (see citation above). Although Applicant is not limited to claiming a single microprocessor and/or microcomputer, the claimed essential elements comprising parts thereof are not defined in the claims to be in communication with each other and/or appear to be distinct software "units" with distinct functions.

22. In response to Applicant's argument (c) that the elements perform different functions and would most likely be performed by a different part of the microprocessor and/or microcomputer, it is noted that the features upon which applicant relies (i.e., the elements perform different functions and would most likely be performed by a different part of the microprocessor and/or microcomputer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

23. In response to applicant's arguments (d), (e), and (f) that Kamada does not disclose or suggest the correcting unit that corrects a parameter value associated with the measured bioelectrical impedance by use of a parameter representing an intracellular/extracellular fluid ratio included in the parameter value of the bioelectrical impedance measured at a given frequency, the body composition computing unit that

computes an index associated with a body composition based on the corrected parameter value, and correcting any parameters, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case as broadly as structurally claimed, Kamada discloses a programmable microprocessor capable of the positively recited computing and correcting (as set forth, cited, and reiterated above). The Examiner notes the functional limitations relied upon by Applicant do not positively recite for example a special purpose programmable microcomputer programmed or configured to correct a parameter, compute a parameter value, and/or compute an index, which may structurally distinguish the functional limitations argues by Applicant.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./
Jeff Hoekstra
Examiner, Art Unit 3736

/Max Hindenburg/

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Supervisory Patent Examiner, Art Unit 3736